

REMARKS / ARGUMENTS

In response to the Office action dated October 6, 2003, Applicants respectfully request the Office to enter the following amendments and consider the following remarks. Claims 1-11 and 17-20 are pending in this application, and claims 12-16 have been/are being withdrawn. Authorization is hereby given to charge any fees (e.g., extension fees) associated with this response to Deposit Account No. 06-0916.

In the Office action, the Examiner: (i) issued a restriction requirement between claims 1-11 and 17-20 (Group I) and claims 12-16 (Group II); (ii) rejected claim 3 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the invention; and (iii) rejected claims 1-11 and 17-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brett et al. U.S. Patent No. 6,023,685 ("Brett").

Applicants respectfully request reconsideration of the above rejections for the reasons set forth below.

Election / Restriction

Following telephonic indication on September 24, 2003, Applicants hereby confirm the provisional election to prosecute claims 1-11 and 17-20, and the withdrawal of claims 12-16. Election with traverse has been made as it is respectfully submitted that no additional burden exists for the Examiner to search these two groups of claims.

Rejection of Claim 3 under 35 U.S.C. § 112, second paragraph

Claim 3 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the invention

Without acquiescence as to the correctness of this rejection, Applicants have amended claim 3 to more particularly point out and distinctly claim the invention. In light of this change, Applicants respectfully submit that the instant rejection has been overcome.

Rejection of Claims 1-11 and 17-20 under 35 U.S.C. § 103(a)

Claims 1-11 and 17-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brett.

Applicants have encountered confusion with the rejection of these claims over Brett, most notably with the mapping of Brett to the recited claim elements. Therefore, Applicants respectfully request that the Office makes clear the precise allegations of unpatentability, so that arguments (or amendment to the claims, if necessary) that address the Examiner's precise basis/bases can be provided.

Specifically, with regard to the Office action, it is not clear what claims or claim language the discussions from page 6, line 8 through page 7, line 2 address. The statements appear to be a generic assertion of how all of the claims are taught by Brett, however the independent claims do not call for such things as "the bid from the first or second bidders" (e.g., none of the independent claims even reference a "second bidder," this term is only present in dependent claims 7 and 9). Clarification is requested as to which claims are being addressed, as well as the specific language to which the teachings of Brett are being mapped.

Additionally, the rationale contained within the final paragraph on page 6 is unclear. This paragraph begins "[a]s per selecting the sample of bids in a random fashion or are mutually exclusive." Perhaps the difficulty with comprehending this sentence is due only to a simple grammatical error or omission, but Applicants are also not sure how the "mutually exclusive" phrase fits into the Office's position concerning the obviousness of these claims. Again, clarification is respectfully requested. Similarly, the meaning of "one of ordinary skill in the art at the time the invention was made would have provided selecting sample that are mutually exclusive in order to determine winning bids combination" (pg. 6, lines 18-20, emphasis added) is unclear. Applicants desire clarification of this position as it is extremely important for the record to reflect the precise subject/matter of which Official Notice is being taken.

Because no clear issue has been developed between the Examiner and Applicants (see MPEP § 706.07), Applicants respectfully request that the subsequent Office action in this case not be made final. If, however, the primary Examiner believes

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that such action may appropriately be deemed final, Applicants would further respectfully request the opportunity to conduct a telephonic interview with the Examiner(s) prior to issuing such action, so that the Office's position might thereby be clarified and responsive arguments and/or amendments presented.

Applicants lastly also note disagreement with the apparent application of Brett to the claimed subject matter. Claims 1-5 are drawn to "[a] system for vending copies of an electronic work," claim 6-11 are drawn to "[a] method for distributing copies of an electronic work," and claim 17-20 are drawn to a method for distributing a digital file." Brett fails to teach or suggest the claimed systems and methods for disseminating electronic content, however Applicants are unable to clarify these differences by distinguishing/changing the claimed invention until sufficient explanation of the rejection to each of at least the independent claims is provided.

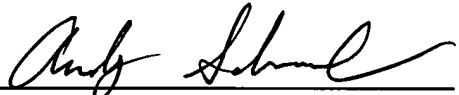
Conclusion

In view of the foregoing remarks, Applicants respectfully request re-issuance of the recent action. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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